

Remarks

This Amendment is in response to the Office Action dated **December 20, 2006**. In the Office Action, the specification was objected to; claim 51 was objected to under 37 CFR 1.75; claims 40-80 were rejected under 35 USC 112; claims 40-80 were rejected under 35 USC 103(a) as being unpatentable over Mackiewicz et al. (2005/0060025).

The following comments are presented in the same order, with section headings, as the Office Action.

Specification

In the Office Action, the specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

Applicant disagrees with the objection. However, to further prosecution, Applicant has amended instant independent claims 40 and 57 and cancelled claims 41 and 58. Applicant reserves the right to use claims 40, 57, 41 and 58 in a later application. Applicant requests withdrawal of the objection.

37 CFR 1.75

In the Office Action, claim 51 was objected to under 37 CFR as being a substantial duplicate of claim 50. Applicant has amended claim 51 to recite “wherein the shape memory material is polymeric.” Applicant has similarly amended claim 71. Support for the amendment can be found the claims as filed. Applicant requests withdrawal of the objection.

35 USC 112

In the Office Action, claims 40-80 were rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement because the claims contain subject matter not described in the specification and under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Applicant disagrees with the rejection. However, to further prosecution, Applicant has amended instant independent claims 40 and 57 and cancelled claims 41 and 58, thereby mooted the rejection. Applicant reserves the right to prosecute claims 40, 57, 41 and 58 in a later application. Applicant requests withdrawal of the rejection.

35 USC 103

In the Office Action, claims 40-80 were rejected under 35 USC 103(a) as being unpatentable over Mackiewicz et al. (US 2005/0060025).

Applicant disagrees with the rejection. However, to further prosecution, Applicant has amended instant independent claims 40 and 57 and cancelled claims 41 and 58. Applicant reserves the right to prosecute claims 40-41 and 57-58 in a later application.

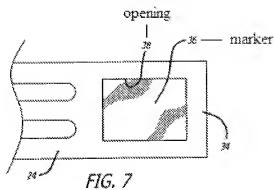
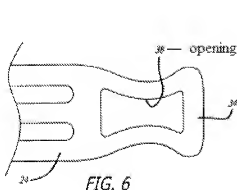
Independent claim 40 as amended includes the recitation:

the receptacle having a first shape when there is no marker therein ... the receptacle having a second shape after the marker is inserted into the receptacle, the second shape the same as the first shape...

Independent claim 57 as amended includes the recitation:

the receptacle having a first shape in the first phase, the receptacle having a second shape in the second phase, the first shape the same as the second shape...

Applicant asserts that Mackiewicz does not teach or suggest all the claim limitations of instant independent claims 40 and 57. As shown in Fig. 6 and 7 of Mackiewicz, provided below, the Mackiewicz receptacle has an hour-glass shape when the marker is not within the receptacle and the receptacle has a rectangular shape when the marker is inserted into the receptacle. Thus, Mackiewicz teaches a first shape different than the second shape, contrary to instant independent claims 40 and 57.



Independent claims 40 and 57 also respectively recite “enlarging the receptacle ... subsequently inserting a marker in the receptacle while the shape memory material is in the martensitic phase” and “enlarging the receptacle ... subsequently inserting a marker in the receptacle while the shape memory material is in the second phase.”

Applicant asserts that Mackiewicz does not teach or suggest enlarging the receptacle and subsequently inserting a marker, as recited in the instant claims. Applicant notes that Mackiewicz does not discuss the steps, let alone the sequence of the steps, used to insert the marker, and thus transition from Fig. 6 to Fig. 7, above. Thus, in Mackiewicz, there is no disclosure as to how to carry out deforming the receptacle and inserting the marker into the receptacle. The instant claims, however, recite enlarging the receptacle and subsequently inserting a marker into the receptacle.

For at least these reasons, Mackiewicz does not render instant independent claims 40 and 57 obvious. Applicant requests withdrawal of the rejection and asserts that claims 40, 42-57, and 59-80 are in condition for allowance.

Conclusion

Based on at least the above, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 40, 42-57, and 59-80 is requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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